



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,305	01/26/2001	Fujio Okita	SHX 317	7659

7590 03/15/2005

Charles H. DeVoe
Kolisch, Hartwell, Dickinson, McCormack & Heuser
520 S.W. Yamhill Street, Suite 200
Portland, OR 97204

EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,305

Applicant(s)

OKITA, FUJIO

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/771,305 received on 25 October 2004.
2. Claims 1 and 3-8 are presented for examination.
3. Claim 2 has been cancelled.

Claim Objections

4. Claim 5 is objected to because of the following informalities: Claim 5 recites the limitation "all of identification codes". Examiner will interpret this limitation as "all of the identification codes". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 1 and 5 recite the limitation "former identification codes" and "latter identification codes". It is unclear to which identification codes "former" and "latter" are referring to. Examiner will interpret the claim as follows: after comparing the caller's

identification code with the identification codes in the database, and no matches were found, meaning no personal data records for the caller were found, then skipping deletion of any personal records in the database because they were not found.

7. Claim 6 recites the limitation "whose identifications are not included". There is insufficient antecedent basis for this limitation in the claim. Examiner will interpret this limitation as "whose identification codes are not included". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Redmond (U.S. Patent Number 6,370,139).

8. Regarding claim 1, Redmond discloses a personal data management apparatus for managing multiple personal data records, each of which contains a unique identification code for identifying an individual data, the apparatus comprising:

a database file storage section for storing personal data records (Redmond, Fig. 8, 424, col. 4, lines 40-50);

a communication control section for establishing a communication connection in response to an incoming call signal via a telephone line from a caller, and for controlling signals via the communication connections (Redmond, col. 8, lines 30-50);

a guidance message control section, for sending out a guidance message via the communication connection which prompts the caller to input his identification code (Redmond, col. 5, lines 40-60); and

a data processing section for storing received identification codes (Redmond, col. 5, lines 60-65), comparing the identification code from the caller with each of the identification codes stored to decide whether or not the former identification code is identical with one of the latter identification codes (Redmond, col. 5, lines 40-65); and then deleting a personal data record for the caller from the database when the former identification code is not identical with any of the latter identification codes (Redmond, col. 9, lines 55-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond in view of Nielsen (U.S. Patent Number 5,864,684).

9. Regarding claim 3, Redmond teaches the limitations, substantially as claimed, as described in claim 1. However, Redmond does not disclose an output section which is capable of outputting the database file processed by the data processing section in a mailing label format including said identification code of said personal data record. In an analogous art of networking, Nielsen discloses a simplified system for handling distribution lists for electronic mail messages wherein information is sent only to user's who email addresses are in the database (Nielsen, col. 2, lines 30-35). Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Redmond with Nielsen to provide a system where users may remove their personal identification data from database systems that supply bulk emailers and telemarketers with this information (Redmond, col. 7, lines 30-35), benefiting users by minimizing the amount of information received in their email.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond in view of Nielsen as applied to claim 3 above, and further in view of Chu (U.S. Patent Number 6,182,119).

10. Regarding claim 4, Redmond and Nielsen teach the limitations, substantially as claimed, as described in claim 3, including wherein said data processing section comprises an identification code storage section, which stores the identification code

received by the communication control section (Redmond, Fig. 8, 424, col. 4, lines 40-50).

However, Redmond and Nielsen do not disclose wherein said data processing section comprises a transmission blocking section which prevents only the personal data records corresponding to the identification codes stored in said identification storage section from being transmitted to the output section.

In an analogous art, Chu discloses a method and system for filtering messages using filter objects which contain subscriber information, wherein at transmission time, the system checks filter objects, which are stored in memory and include subscriber information, if they decide not to take action with the message, preventing the subscriber records from being transmitted (Chu, col. 8, lines 25-50). Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Chu with Redmond and Nielsen to produce a system that filters out subscribers before transmission of messages for the benefit of allowing users to receive only messages of interest (Chu, col. 5, lines 10-15).

Claims 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang in view of Chu (U.S. Patent Number 6,182,119).

11. Regarding claims 5-7, Redmond discloses a personal data management apparatus for managing multiple personal data records, each of which contains a unique identification code for identifying an individual data, the apparatus comprising:

a database file storage section for storing personal data records (Redmond, Fig. 8, 424, col. 4, lines 40-50);

a communication control section for establishing a communication connection in response to an incoming call signal via a telephone line from a caller, and for controlling signals via the communication connections (Redmond, col. 8, lines 30-50);

a guidance message control section, for sending out a guidance message via the communication connection which prompts the caller to input his identification code (Redmond, col. 5, lines 40-60); and

a data processing section for storing received identification codes (Redmond, col. 5, lines 60-65), comparing the identification code from the caller with each of the identification codes stored to decide whether or not the former identification code is identical with one of the latter identification codes (Redmond, col. 5, lines 40-65); and then deleting a personal data record for the caller from the database when the former identification code is not identical with any of the latter identification codes (Redmond, col. 9, lines 55-63).

However, Redmond does not disclose outputting only the personal data records whose identification codes are not included in said reception code memory.

In an analogous art of networking, Chu discloses a method and system for checking filter objects for subscribers that choose not to take action in the message being transmitted and not transmitting the message to them (Chu, col. 8, lines 25-50).

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Chu with Redmond to produce a system that filters out

subscribers before transmission of messages for the benefit of allowing users to receive only messages of interest (Chu, col. 5, lines 10-15).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond in view of Chu as applied to claim 5 above, and further in view of Nielsen (U.S. Patent Number 5,864,684).

12. Regarding claim 8, Redmond and Chu teach the limitations, substantially as claimed, as described in claim 5. Chu also discloses sending messages to subscribers (Chu, col. 8, lines 50-51). However, neither Chu nor Redmond explicitly state wherein the personal data records are output in a mailing label format, which includes said identification code. In an analogous art, Nielsen discloses a system wherein users subscribed to a mailing list are sent messages in a mailing label format, including their identification (Nielsen, col. 2, lines 30-35). Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Chu with Zhang and Nielsen to produce a system that filters out subscribers before transmission of messages for the benefit of allowing users to receive only messages of interest (Chu, col. 5, lines 10-15) in a mailing label format.

Response to Amendment

13. Applicant's arguments and amendments filed on 25 October 2004 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations in the independent claims requiring further search and consideration*) to the claims which significantly affected the scope thereof.

14. Applicant's arguments with respect to claims 1 and 3-8 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of a data management apparatus configured to compare a received identification code with stored identification codes in order to facilitate the deletion of a personal data record at the request of a caller included in a personal data database [see Applicant's Response, page 8]. It is evident from the mappings found in the above rejection that the combination of Redmond discloses the teaching of providing information dispersal where a caller requests to have their data removed from a database. Further, it is clear from the numerous teachings (previously and currently cited) that the provision for using "identification codes in a database" was widely implemented in the networking art.

15. Applicant only claims comparing information in a database to a code supplied by a user. By Redmond including a request from the caller to disperse their information and the database doing so, Redmond shows that the request data is compared to data in the database.

16. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that the combination of Redmond and Chu clearly teach the independent claims of the Applicant's claimed invention.

17. Applicant's arguments with respect to claims 1 and 3-8 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

18. Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Redmond and Chu as well as other prior arts of records disclosed information dispersal is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

19. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

20. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends

Art Unit: 2143

broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.
Patent Examiner
Art Unit 2143



BUNJOD JAROENCHONWANIT
PRIMARY EXAMINER